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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,063	07/13/2001	Jun Watanabe	450100-03345	3458
20999 7590 02/18/2009 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL.. NEW YORK, NY 10151				
EXAMINER				
BOCCIO, VINCENT F				
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2169				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/905,063

**Applicant(s)**

WATANABE ET AL.

**Examiner**

Vincent F. Boccia

**Art Unit**

2169

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Amend. Resp 11/3/2008 & RCE of 12/2/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2169.

***Response to Arguments***

1. Applicant's arguments with respect to amended claims 13-24 have been considered but are moot in view of the new ground(s) of rejection.

**Claim Rejections - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tsumagari et al. (US 6,480,669) and Boreczky et al. (US 6,366,296), as applied and further in view of Browne et al. (WO 92/22983).

Regarding newly amended claims 13-24, have been further amended **to further recite**, claims 13 and 19:

o simultaneous recording video and/or audio and reproducing the video and/or audio;

and

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- o list of videos or audios recorded NOT YET REPRODUCED.

The examiner cites **Browne**

- o SEE Fig 6, Viewed ATTRIBUTE Index Information, indicating VIEWED OR REPRODUCED, ALSO SEE FIG. 3, RECORDING ERASURE SCHEMES, OLDEST - VIEWED is also identified by the system during recording and
- o the system is also adapted for any of:
  - o simultaneous R & R
  - o simultaneous recording plural, as well as reproduction (see pages 2, 3), as taught by Browne.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify **Tsumagari** in view of **Boreczky** to include, listing information for videos recorded NOT YET REPRODUCED and adapt the system to perform R & R simultaneously, as taught by Browne, the listing of viewed or reproduced or not for informative purposes to users is assistive to determine new vs. viewed programs and also the ability to perform R & R allows for a higher level of functionality to allow for rendering, during recording each feature enhances the overall Video device, as is deemed obvious to those skilled in the art.

Regarding claims 13 and 19, Tsumagari discloses and meets the limitations associated with a video recording/reproducing method and apparatus capable of recording to a medium and reproducing video from the medium comprising:

- recording video or audio signals and ID signals (see Fig. 27) indicating the content of the video and audio signals, into a recording medium (Fig. 26, PG1 & PG2, Fig. 29, TV tuner, A & V signal);
- list generating a title lists (Figs. 35, 39, 45, 48 and Figs. 26, 29, 32, 34, 36, 37, 44, 47, 51-53, also see col. 29, lines 18 to col. 33) of videos or audios recorded in the recording medium using the ID signals (Fig. 17, USER DEFINED PGC sequence and Fig. 27); and

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- reproducing one or more videos or audios in the title list and reproduces sequentially part of each video or audio (see user defined chains, PGC videos/sections of video, see Fig. 27, PLAY LIST #1 comprises parts of program 1 and parts of program 3, that is play list # 1, also see #2 play list parts of 2 & 4).

*Regarding claims 13-24, claim 13 etc., further recite:*

*o non-user generated content and that reproducing automatically sequentially part of each audio or video, being an introduction playback mode (PART OF, any portion), based on the above Tsumagari fails to anticipate the claims as amended.*

The examiner cites, Boreczky, which teaches, col. 2, automatic preview or an introduction playback mode for recorded material, as taught by Boreczky, wherein user can browse by system automatic preview mode.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify **Tsumagari** by incorporating automatic playback sequence generation, providing browsing capability to preview recorded materials to provide automatic creation of introduction playback modes or sequences, of recorded content of Tsumagari, as taught by **Boreczky** in order to automate playback sequence generation.

Regarding claim 14, Tsumagari discloses and meets the limitations associated with

- o sorting audio or video titles in order of:
  - o date (Fig. 35, col. 30, lines 54-56); or
  - o title; or
  - o classification (reads on user defined play list and/or based on an attribute, such as Fig. 35, sorted by, "MARK REC DATE"); or
  - o recording in response to a received user indication (col. 29, line 65 to col. 30, line 4, Fig. 35, see time column, increasing time, also see Mark Rec Dates with time, in sequence 1st-{99.01.02 16:00}, 2nd-{99.01.03 14:00} and 3rd-{99.01.03 15:00}, also see attribute column,

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"USER", user dictated entry points, being bookmarks (col. 29, line 66 to col. 30, line 7, "pause", creates bookmarks, user interaction).

The scope of claim 14 deems that only one limitation is required to meet the claim.

Regarding claim 15, Tsumagari discloses and meets the limitation of sorting the titles of the recorded video or audio that have been automatically recorded by a timer (either met by a recording timer for events {col. 25, lines 54-60, "TIMER RECORDING", and/or col. 27, lines 10-15, "TIMER PLAYBACK" and/or col. 29, lines 25-55 ....} or timer entry point generation, see Menu Fig. 35 and Play lists).

The user can change the order by PGC ordering (PLAY LIST) and the system includes a timer (col. 29, lines 17-20, "entry point at time intervals" or col. 27, lines 11-15, "timer", Fig. 35).

Regarding claim 17, Tsumagari discloses and meets the limitation of receiving a user indication of sorting the video or audio titles and sorting in accordance as users desires (Fig. 27, user created play lists of parts of multi-media material (video w/audio) recorded to the medium); and providing the sorted title list to the user (met by rendering the play list with the system or playback, Fig. 29, "48").

Regarding claim 18, Tsumagari discloses and meets the limitation of having thumbnail images for titles sorted (see Fig. 35, menu of titles/programs, having, "THUMBNAIL", images for each title).

Regarding claims 16 and 22, Tsumagari discloses and meets the limitation of user created play list of parts of multimedia and reproducing in accordance with parts that can be any portions of the video or audio material (Fig. 27).

Since the system is adapted to allow users can pick any parts of the titles to create desired a play back sequences (parts of title/program materials, play list, Fig. 27), the examiner renders it obvious to create a sequence of parts corresponding to beginning parts of video

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or audio in the recorded titles/programs recorded to the medium, as an introduction playback sequence, which is a preview sequence operation of recorded material, the sequence showing what is recorded in a sequence of beginning section of recorded programs.

To reinforce the examiner's position of obviousness, since applicant Tsumagari had not specifically stated the idea of a sequence having beginning portions or parts of selected videos and audios or user generating, "AN INTRODUCTION PLAYBACK", in Fig. 27, Tsumagari suggests this operation,

see PLAYLIST #1, "having a beginning Part of Program 1"; and "having a beginning Part of Program #3".

Therefore, it is deemed obvious if not inherent, that users with **Tsumagari in front of themselves**, can create "INTRODUCTION PLAYBACK SEQUENCES", corresponding to BEGINNING PARTS OF RECORDED multimedia, in view of Fig. 27 and what is deemed obvious to those skilled in the art.

Upon user selection of an introduction playback being a predetermined amount of time corresponding to a beginning parts of the titles/programs recorded.

The system allows users to create sequential reproduction of parts that can be the beginning parts as desired as is obvious of not met by the applied art.

Claims 20, 21 and 23-24 are analyzed and discussed with respect to **Tsumagari supra**.

#### **Contact Information**

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record Vincent F. Boccio whose telephone number is (571) 272-7373.

The examiner can normally be reached on between Monday-Thursday between (7:30 AM to 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali, can be reached on (571) 272-4105.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vincent F. Boccio/  
Primary Examiner, Art Unit 2169